

Serial No.: 09/705,579

Patent Docket P1053R1D1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Brian M. Fendly Serial No.: 09/705,579 Filed: November 2, 2000 For: ANTI-ErbB2 ANTIBODIES	Group Art Unit: 1643 Examiner: Christopher Yaen Confirmation No. 5667 Customer No. 09157  Electronically Filed On:  September 28, 2006
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Petition under 37 CFR 1.182 Requesting Withdrawal of a  
Recorded Terminal Disclaimer

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This petition is being filed in order to request withdrawal of a previously filed and recorded terminal disclaimer (TD) in the above application. Here are the facts surrounding recordal of that TD and this request for withdrawal thereof.

1. On March 1, 2004 a TD to obviate an obviousness-type double patenting rejection of then pending claims 42, 44, 55, 63 and 65 over a prior patent, namely US Patent No. 5,720,954 to Hudziak et al. ("the '954 patent"), was filed in the above-identified application.

2. Applicant explained in the accompanying amendment that the TD was being filed in order to expedite prosecution, without acquiescing in the rejection (see Amendment dated March 1, 2004, page 6).

3. Since filing the TD, former claims 42, 44, 55, 63 and 65 have been cancelled (see Amendment dated April 19, 2006), and the Office has indicated that newly presented claim 71 of the above application is

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allowable (see Office Action dated July 12, 2006, page 5).

4. The undersigned met with the Examiner in a personal interview on September 27, 2006. At that time, Applicant indicated that claims 69 and 70 would be cancelled, and a new petition to remove the TD would be filed. The Examiner indicated that the "rejection under 35 USC 103(a) over Hudziak et al. (US Patent 5,720,954) in view of Pauwels et al would be moot in view of the cancellation of claim 69. Claim 71 is deemed allowable over the prior art in view of unexpected results, which are commensurate in scope." (Interview Summary dated September 27, 2006).

5. Claim 69 is cancelled in the accompanying amendment. Applicant submits that a TD over the '954 patent is mooted by the Office's finding that claim 71 is not anticipated nor obvious over the '954 patent (Interview Summary dated September 27, 2006).

6. In view the above-noted facts, Applicant requests, by way of this petition, that the recorded TD filed March 1, 2004 be withdrawn.

7. Applicant notes that a previously filed petition to withdraw the TD was dismissed (see Decision on Petition mailed June 22, 2006). However, that previous petition concerned different facts, including, in particular, previous claim 69, which is cancelled in the accompanying amendment. The present petition is a stand alone, new petition, rather than a renewed petition.

8. In the event the attorney in the Office of Petitions reviewing this petition has any questions concerning this petition, he or she is cordially invited to call the undersigned at the number noted below in order to discuss same.

The U.S. Patent and Trademark Office is hereby authorized to charge Deposit Account No. 07-0630 in the amount of \$400.00 to cover the cost of this Petition under 37 CFR §1.17(f). Any deficiency or overpayment should

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be charged or credited to this deposit account. A duplicate of this sheet is enclosed.

Respectfully submitted,  
GENENTECH, INC.

Date: September 28, 2006

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